Paper No. 26

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte PHILIP S. JONES
and DAVID S. MURRAY

_____

Appeal No. 1996-3083
Application 08/139,692[1]

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HEARD: OCTOBER 5, 1999

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Before THOMAS, FLEMING and FRAHM, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

[1] Application for patent filed October 22, 1993.

Appellants have appealed to the Board from the examiner's final rejection of claims 9 through 15. Representative claim 9 is reproduced below:

9. An equipment management system having at least one piece of equipment controlled by an equipment manager via an equipment controller, said equipment controller and equipment manager being arranged to respond to and produce information messages having a plurality of fields according to a first and a second protocol, respectively, in which said equipment management system includes a computer implemented interface between said equipment controller and said equipment manager for translating an original information message in said first protocol to a translated information message in said second protocol, said interface comprising:

a plurality of program modules, each of which has at least one input and at least one output, each program module being arranged to perform a predefined action on data received at its said at least one input, outputs of some of said program modules constituting inputs of others of said program modules thereby defining a network of program modules;

said program modules including a plurality of modules of a first type, each of which is responsive to said original information message having respective predefined information in a first field and a plurality of program modules of a second type, each of which is responsive to said original information message having respective predefined information in a second field;

one of said modules of said first type being arranged to receive an original information message and, in the absence of detecting its respectively associated predefined information in said first field of an original message, to output such original message to an input of another one of said modules of the first type;

each module of said first type being arranged, on detecting its respectively associated information in said first field, to output a message which includes at least a portion of such original information message to an input of one of said modules of the second type;

at least one of said modules of said second type being arranged, in the absence of detecting its respectively associated predefined information in said second field, to output the message which it receives at its input to an input of another one of said modules of said second type;

each module of said second type being arranged, on detecting its respectively associated predefined information in said second field, to produce at an output a message which includes an indication that such information has been detected successfully; and

said program modules including at least one program module which, on receiving a message at an input produces at an output a message which includes an information stream according to said second protocol.

The following reference is relied upon by the examiner:

Brown et al. (Brown) 5,060,140 Oct. 22, 1991

Claims 9 through 15 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Brown and, separately, under 35 U.S.C. § 103, as being obvious over Brown alone.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and the answer for the respective details thereof.[2]

OPINION

We reverse both stated rejections for the reasons generally set forth by appellants in the brief.

The examiner's positions, however, are also flawed from the outset. As to both rejections under 35 U.S.C. §§ 102 and 103, the examiner's basic approach in the final rejection, as well as in the answer appears to be setting forth a concept-type rejection. To the extent the examiner relies upon inherency under 35 U.S.C. § 102 that branching is inherently present in Brown's translation network, and the examiner's additional position that Brown does not explicitly teach branching in accordance with the rejection under 35 U.S.C. § 103, this latter position under 35 U.S.C. § 103 essentially admits the weakness in the position of inherency advocated

[2] We note that appellants' reply brief filed on October 16, 1995 has not been entered by the examiner in accordance with the letter dated November 8, 1995. As such, we have note considered it in our deliberations.

under the rejection of the claims under 35 U.S.C. § 102. As appellants correctly point out at pages 12 and 13 of the brief, inherency requires much more than probabilities or possibilities. The examiner has not shown to us that branching between program modules or "softblocks" within Brown occurs in a manner recited in independent claims 9 and 14 on appeal. Inherency requires an asserted thing to be necessarily inherent and not merely possibly inherent.

The general showings in Figures 3, 8, and 11 of the interconnectability of the various tasks within each protocol conversion module are essentially linear in nature and do not show any branching between them. The examiner admits as much at page 5 of the Answer. On the other hand, even if the examiner is correct in observing that Figures 6 and 7 of Brown do appear to show that branching does occur within each program module, we do not agree with the examiner's conclusion that on the basis of these two figures branching would have been a necessarily inherent part or it would have been obvious to the artisan to have implemented branching between program modules or softblocks. At the level of disclosure of Brown

for his modules, we conclude that it would not have been obvious to the artisan to have implemented the kind of branching between program modules required by independent claims 9 and 14 on appeal.

In any event, the examiner's position in the final rejection and answer does not present for the reader a detailed analysis of the actual claim language and relationships recited therein to any specific teachings of Brown. Instead, the examiner's position is basically a generalized or concept-oriented type of rejection under both 35 U.S.C. §§ 102 and 103 believing the reader, the artisan and us would in effect fill in the blanks to determine any type of correlation on a detailed basis from the teachings of Brown to the subject matter of the various relationships among the modules recited in claims 9 and 14 on appeal. It is the examiner's burden to prove to us that the subject matter of the recitations in independent claims 9 and 14 on appeal, at a minimum or as a starting point, are individually shown or anticipated by Brown under 35 U.S.C. § 102 or would have been otherwise obvious in light of Brown's teachings and

suggestions to the artisan within 35 U.S.C. § 103. This, the examiner has failed to do.

In view of the foregoing, the decision of the examiner rejecting independent claims 9 and 14 and their respective dependent claims alternatively under 35 U.S.C. §§ 102 and 103 is reversed since we do not sustain either rejection.

REVERSED

James D. Thomas Administrative Patent Judge	)	
Michael R. Fleming Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Eric S. Frahm Administrative Patent Judge	)	

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